

REMARKS

The presently-claimed invention relates to novel mammalian REMODEL polypeptides.

Claims 21, 37 and 43 are pending in the current application. The Examiner has withdrawn claims 38, 40 and 44 as being drawn to the non-elected invention.

Claim Election

While not necessarily in agreement with the Examiner's classification of claim 44 as being drawn to the "non-elected invention," Applicants nonetheless hereby acknowledge the Examiner's withdrawal of claim 44 from consideration, as being drawn to the non-elected invention.

Rejection Under 35 U.S.C. § 102(e)(1)

Claims 21, 37 and 43 were rejected under 35 U.S.C. § 102(e)(1) as being anticipated by U.S. Patent Application Publication No. 2004/0146862 of Mack et al. ("Mack"). Specifically, it is the Examiner's view that Mack teaches SEQ ID NO:4 of the present invention. Applicants respectfully submit that claims 21, 37 and 43 are not anticipated by under 35 U.S.C. § 102(e)(1) Mack for the following reasons.

35 U.S.C. § 102(e)(1) provides that:

A person shall be entitled to a patent unless –
(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent[.]

It is well settled that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131 (quoting *Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Id.* (quoting *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Therefore, Mack must describe each and every element of each of claims 21, 37 and 43 in order to anticipate the claim under 35 U.S.C. § 102(e)(1).

However, Mack does not meet this burden. Applicants respectfully submit that Mack was not "filed in the United States *before*" Applicants' present invention. Applicants

submit herewith a Declaration of inventor Dr. Volkhard Lindner under 37 C.F.R. § 1.131. This Declaration sets forth that the presently-claimed invention was invented *prior to* the earliest priority date of Mack, namely, March 15, 2000.

Because Mack was not filed in the United States before Applicants' present invention, Mack cannot constitute prior art with regard to claims 21, 37 and 43. Therefore, Mack cannot anticipate claims 21, 37 and 43 under 35 U.S.C. § 102(e)(1), and Applicants respectfully request reconsideration and withdrawal of the rejections.

Summary

Applicants respectfully submit that the pending claims are fully supported in the specification as filed, and that no new matter has been added by way of the present Response. Applicants also note that they are prepared to cancel the withdrawn claims upon notification that pending claims 21, 27 and 43 are in condition for allowance.


Favorable examination and allowance of the claims is hereby requested.

Respectfully submitted,

VOLKHARD LINDNER, ET AL.

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(Date)

By:


THOMAS M. SOSSONG, JR., Ph.D., J.D.
Registration No. 48,463
DRINKER, BIDDLE & REATH, LLP
One Logan Square
18th and Cherry Streets
Philadelphia, PA 19103-6996
Telephone: (215) 988-2700
Direct Dial: (215) 988-2562
Facsimile: (215) 988-2757
E-Mail: thomas.sossong@dbr.com
Attorney for Applicants

Enclosures: Declaration of Volkhard Lindner under 37 C.F.R. § 1.131
Petition for Two-Month Extension of Time (and accompanying fee)

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